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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,095	07/06/2001	Tomonori Hamada	1602-0173P	2746
2292	7590	09/02/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			STRIMBU, GREGORY J	
			ART UNIT	PAPER NUMBER
			3634	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)
	09/899,095	HAMADA ET AL.
	Examiner Gregory J. Strimbu	Art Unit 3634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 August 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1, 18, 26-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,18 and 26-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on February 4, 2003 and July 16, 2003 have been approved.

Claim Rejections - 35 USC § 112

Claims 26-37 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "configured to prevent . . . engages the door glass" on lines 16-17 of claim 26 render the claims indefinite because it is unclear how a protrusion on the first leg can prevent a distal end portion of the first lip from engaging the door glass. It appears that it is the curvature of the first lip that prevents the distal end portion of the first lip from engaging the door glass rather than the protrusion. Recitations such as "first" on line 2 of claim 29 render the claims indefinite because the applicant has failed to set forth a second notch. Recitations such as "contact" on line 2 of claim 33 render the claims indefinite because it is unclear if the applicant is referring to the contact set forth above or is attempting to set forth another contact in addition to the one set forth above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26-28, 32-34 and 38-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki et al. Nozaki et al., in figure 3, discloses a door glass run 4 attached to a door sash 2 of a vehicle for sealing between the door sash and a door glass 3, comprising a door glass run body having a substantially U-shaped cross section and including a bottom wall (not numbered, but shown in figure 3) and first 42 and second 43 legs projecting from the bottom wall, the first and second legs each having an end portion (not numbered, but shown in figure 3) and first 44 and second 45 lips extending from the first and second end portions toward the bottom wall, the first lip having a proximal end (not numbered, but shown in figure 3) connected to the first leg end portion, a distal end portion (not numbered, but shown in figure 3), and a center portion (not numbered, but shown in figure 3) between the distal end portion and the proximal end, the first and second lips adapted to slidably engage the door glass, a portion of the first leg defining a protrusion 46 having an arcuate first lip engaging surface (not numbered, but shown in figure 3), the protrusion being configured to prevent the distal end portion from contacting the door glass when the center portion engages the door glass.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3634

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki et al. in view of Hayashi et al. Nozaki et al., in figure 3, disclose a door glass run attached to a door sash 2 of a vehicle for sealing between the door sash and a door glass 3 having a first surface and a second surface comprising a door glass run body 4 formed into a substantial U shaped cross section which has a first side portion 42, a second side portion 43 and a bottom face portion (not numbered, but shown in figure 3), a first lip 44 extending from an edge of the first side portion toward the bottom face portion and slidably contacting with the first surface of the door glass, and a second lip 45 extending from an edge of the second side portion toward the bottom face portion and slidably contacting with the second surface of the door glass, wherein a length of the first lip is set so that when the door glass presses the second lip against the second side portion, the first lip contacts the first surface of the door glass, a length of the second lip is set so that when the door glass presses the first lip against the first side portion which includes the protrusion 46, the second lip contacts the second surface of the door glass. Figure 3 of Nozaki et al. is silent concerning a notch.

However, figure 1A of Nozaki et al. discloses a concave notch portion 442 at a base portion thereof.

It would have been obvious to one of ordinary skill in the art to provide figure 3 of Nozaki et al. with a notch, as taught by figure 1A of Nozaki et al., to ensure that the first lip is bent easily.

Additionally, Hayashi et al. discloses a weather strip comprising a notch 38 having a depth of 0.5mm.

It would have been obvious to one of ordinary skill in the art to provide the notch with a depth, as taught by Hayashi et al., to insure the proper pivoting movement of the lip as the lip engages the glass.

Claims 29, 35 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki et al. as applied to claims 26-28, 32-34 and 38-40 above, and further in view of Dover. Dover discloses a door glass run 30 having a first leg (not numbered, but shown on the right in figure 1) and a first lip (not numbered, but shown on the right in figure 1), the first leg includes a concave notch (not numbered, but shown at the juncture of the first leg and first lip) adjacent and partially defined by the proximal end of the first lip.

It would have been obvious to one of ordinary skill in the art to provide Nozaki et al. with a notch, as taught by Dover, to increase the ease with which the first lip can pivot with respect to the first leg.

Claims 30, 31, 36, 37 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki et al. in view of Dover as applied to claims 29, 35 and 41 above, and further in view of Hayashi et al. Nozaki et al., as modified above, is silent about a particular depth of the notch.

However, Hayashi et al. discloses a weather strip comprising a notch 38 having a depth of 0.5mm.

It would have been obvious to one of ordinary skill in the art to provide the notch of Nozaki et al., as modified above, with a depth, as taught by Hayashi et al., to insure the proper pivoting movement of the lip as the lip engages the glass.

Response to Arguments

Applicant's arguments filed August 2, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Hayashi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hayashi is clearly within the applicant's endeavor of providing weather stripping for a vehicle.

The applicant's comments concerning Nozaki et al. with respect to claim 44 are moot in view of the new grounds of rejection.

The applicant's comments concerning Keys and British Patent Application No. 2,334,064 are moot in view of the new grounds of rejection.

With respect to the applicant's comments concerning Nozaki et al., the examiner respectfully disagrees. Figure 3 of Nozaki et al clearly shows a protrusion 46 defined by

Art Unit: 3634

the sidewall. Note that the glass guide 44 is formed on the sidewall 42 as set forth on lines 26-28 of column 1. Therefore, the sidewall 42 defines a protrusion 46. The claim language does not require that the protrusion be made from the same material as the sidewall. Additionally, the lip 44 will not contact the sidewall 42 when the glass 3 is disposed in the glass run. Note that the lip 44 has a thickness of approximately 5mm which is much less than the distance between the glass 3 and the sidewall 42. Accordingly, the lip 44 would not engage the sidewall 42 when the glass 3 is disposed in the glass run. Finally, Nozaki et al. discloses that the first lip contacts the glass 3 when the glass presses the second lip 45 into the second sidewall 43. The glass is approximately 12mm in thickness, the second lip is approximately 5mm in thickness and the first lip in the unstressed state is approximately 13mm from the second wall 43. Therefore, if the glass 3 were positioned such that the second lip 45 were in contact with the second sidewall 43, the surface of the glass 3 facing the first lip 44 would be 17mm away from the second sidewall 43. Since the first lip 44 is only 13mm from the second sidewall 43 in its unstressed state, the glass 3 would contact the first lip 44. The same analysis would apply for the second lip 45 contacting the glass when the first lip 44 contacts the protrusion 46.

Conclusion

THIS ACTION IS NOT MADE FINAL.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-

305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory J. Strimbu
Primary Examiner
Art Unit 3634
August 31, 2004